

II. Remarks

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1-20 and 45-87 are pending in the application. Claims 1, 45, and 46 are independent.

Applicants have added new dependent Claims 47-87 to afford themselves a scope of protection commensurate with the disclosure. The new claims are fully supported in the specification and Drawings, and are believed to be allowable for the reasons to be developed below.

Claims 1 - 20, 45 and 46 were rejected as being unpatentable over Brown, alone or in various combination with, Gregory, Hostettler, Bonk, Yuasa, and Burchi, for the reasons discussed on pages 2 - 8 of the Office Action. Applicants respectfully traverse all art rejections.

Independent Claim 1 recites a novel combination of structure and/or function whereby a foam seat element comprises an isocyanate-based foam matrix having a seat surface. At least a portion of the seat surface comprises at least one air channel having an air channel surface, **the air channel surface being coated with a substantially fluid impermeable material.**

Likewise, independent Claim 45 recites a novel combination of structure and/or function whereby a foam vehicle seat portion comprises an isocyanate-based foam

matrix having a seat surface. At least one gas channel is disposed in the matrix and has a gas channel surface. At least a portion of the gas channel surface is coated with a substantially gas impermeable material to retard diffusion of gas through the gas channel surface into the foam matrix.

Furthermore, independent Claim 46 recites a novel combination of structure and/or function whereby a foam vehicle seat element comprises an isocyanate-based foam matrix having a seat surface, at least a portion of the matrix surface being air-permeable. An air channel is disposed in the matrix surface, and an air channel surface is disposed on at least a portion of the air channel. The air channel surface comprises a substantially air-impermeable material which substantially prevents diffusion of air through the gas channel surface into the foam matrix. An air permeable covering is disposed over the air channel to permit air to flow from the air channel through the covering.

In contrast, Brown discloses a door panel sound absorber, not a vehicle seat element. Therefore, none of the claims can be anticipated by Brown.

Gregory merely discloses well known seat cushions with air channel therein. However, such air channels allow the air moving in the channel to escape into the foam matrix,

preventing the air from reaching all parts of the channels. This is precisely the problem which the subject application cures by coating the channels with an air or gas impermeable material. However, the Office Action proposes to combine Gregory with Hostettler (arm rest having an elastomer skin) to produce the claimed invention, reasoning that one of ordinary skill in the art would have recognized that the isocyanate based foam matrix seat should be impervious to oil and water. Respectfully, this is classic hindsight reconstruction; using Applicants' disclosure as a guide to combine disparate references. The "motivation" provided is Applicants' own teaching.

To prevent such hindsight reconstruction, the law is clear that a *prima facie* case of obviousness can be established **only** by showing some **objective** teaching in the cited art which would lead an individual of ordinary skill in this art to combine the relevant references. See *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Patent Office Board of Appeals 1993). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined **only** if there is some suggestion or incentive to do so. The mere fact that the prior art may

be modified does not make the modification obvious unless the prior art suggested the desirability of the modification.

See *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1578, 221 USPQ 929, 933 (Fed. Cir. 1984). It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.

See *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

It is well established that, in order to sustain a rejection under 35 U.S.C. §103, it is the burden of the USPTO to establish a *prima facie* case of obviousness, *In re Reuter*, 651 F.2d 751, 210 USPQ 249 (CCPA 1981). In asserting such a case of obviousness, the Examiner must propose some modification of a particular reference or a combination thereof with another reference in order to arrive at the claimed invention. In this regard, the teachings of a single prior art reference or a primary prior art reference (which is combined with one or more secondary prior art references) must be sufficient to justify a conclusion that any proposed modification or combination of references is what one of ordinary skill in the art would have found obvious to do at the time the invention was made, *In re Linter*, 458 F.2d 1013, 173 U.S.P.Q. 560, 562 (CCPA 1972). Moreover, the Courts have held that there must be some logical reason apparent from the evidence of record that would justify a modification or

combination of prior art references, *In re Regel*, 188 USPQ 132 (CPPA 1975). If there is no such reason, the *prima facie* case of obviousness has not been made out, *Oscar Mayer Foods Corp. v. Sara Lee Corp.*, 15 USPQ (2d) 1204, (D.C. Wis., 1990).

Hindsight combination of references is not a valid basis for rejection under 35 U.S.C. §103, *In re Adams*, 148 U.S.P.Q. 742 (CPPA 1966) and *In re Skoll*, 187 U.S.P.Q. 481, 484 (CCPA 1975). Further, in *Twin Disc Inc. v. United States*, 10 Cl. Ct. 713; 231 USPQ 417, 425 (Cl. Ct. 1986), the Court stated:

... it is now clear beyond cavil that it is not permissible to ascertain factually what the inventors did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct the claimed invention.

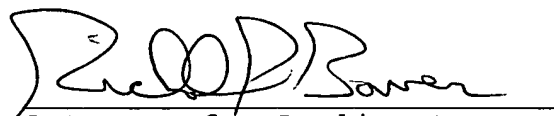
Citing *Orthopedic Equipment Co., Inc. v. United States*, 702 F.2d 1005, 1012; 217 USPQ 193, 199 (Fed. Cir. 1983), the Court in *Twin Disc* further stated that it is incorrect to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.

Accordingly, Applicants respectfully traverse the obviousness rejections and submit that the pending claims recite combinations of structure and/or function nowhere disclosed or suggested by the cited art.

In view of the above amendments and remarks, it is believed that this application is now in condition for allowance, and a Notice thereof is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3507. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard P. Bauer", written over a horizontal line.

Attorney for Applicants
Richard P. Bauer
Registration No. 31,588

PATENT ADMINISTRATOR
KATTEN MUCHIN ZAVIS ROSENMAN
525 West Monroe Street
Suite 1600
Chicago, Illinois 60661-3693
Facsimile: (312) 902-1061